



# UNITED STATES PATENT AND TRADEMARK OFFICE

EA

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/803,179

03/17/2004

Sung Hwan Moon

200146.402C3

4168

500

7590

06/21/2006

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC  
701 FIFTH AVE  
SUITE 6300  
SEATTLE, WA 98104-7092

EXAMINER

HABTE, KAHSAY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/803,179

Applicant(s)

MOON ET AL.

Examiner

Kahsay Habte

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-12,16-24 and 26-36 is/are pending in the application.
- 4a) Of the above claim(s) 16-24 and 26-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/976,470.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/24/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-2, 5-12, 16-24 and 26-36 are pending in this application.

***Response to Amendment***

2. Applicant's amendment filed 4/26/2006 in response to the previous Office Action (Paper No. 3) is acknowledged. Rejections of claims 1,2 and 5-13 under 35 U.S.C. § 112, second paragraph (items 6b-6d) have been obviated. The second paragraph rejection (item 6a) has been maintained.
3. It is recommended that applicants delete non-elected inventions in response to this Office Action.

***Information Disclosure Statement***

4. Applicant's Information Disclosure Statement, filed on 5/24/2006 has been acknowledged. Please refer to Applicant's copies of the 1449 submitted herewith.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 and 5-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

Art Unit: 1624

which applicant regards as the invention. Claim 1 and claims dependent thereon are rejected because the phrase “an amino acid side chain derivative, a linker, and a solid support” is indefinite. What is covered by said phrase and what is not? What linker? What solid support? Applicants have to recite “amino acid side chain derivative”, “linker” and “a solid support” to overcome this rejection.

### ***Response to arguments***

Applicant's argument filed 04/26/2006 has been fully considered but it is not persuasive.

Applicants argue, “one of ordinary skill in the art, in view of the present application, would know what phrases in the above-noted language mean....As the term ‘amino acid chain derivatives,’ the present application provides that such term includes modifications and/or variations to naturally occurring amino acid chain moieties.....Regarding ‘linker,’ the present application provides that such term refers to a group that facilitates the linkage of the compound with formula (I) to another moiety or compound....the term ‘solid support,’ Applicants submit that one of ordinary skill in the art would understand this term include any solid material to which a compound with formula (I) may be linked”. The examiner disagrees with applicants' arguments. What are amino acid chain derivatives? What is considered a derivative of amino acid chain and what is not? Note that a derivative is an open-ended language. Where is the complete list? According to the specification, the derivatives are not limited to the examples given in the specification. It is recommended that applicants delete “amino

Art Unit: 1624

acid chain derivatives” or recite specific amino acid chain derivatives to overcome this portion of the rejection.

In regard to “linker” and “solid support”, there is no sufficient guidance in the specification for the definition of said terms. Applicants are silent in providing examples that are linkers or solid supports. Linker is defined as “a group that facilitates the linkage of the compound with formula (I) to another moiety or compound”. What is linked to what? What is “another moiety”? How can one tell what it is? How is the linker attached to another moiety?

In regard to “solid support”, there is no guidance in the specification for one skilled in the art to understand it means. Applicants indicate “the mimetics may be synthesized on a solid support (such as PAM resin), but this would not provide sufficient guidance for one skilled in the art to understand what solid support mean. What are covered by solid support and what are not? How is solid support attached to the rest of compound?

It is recommended that applicants delete “a linker and a solid support” from claims 1 and 9-11 to overcome this rejection. Note that these are not a standard chemical terms unless they are clearly defined in the specification or specific examples of said terms are recited in the claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1624

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9:00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 1624

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Kahsay Habte', written in a cursive style.

Kahsay Habte  
Primary Examiner  
Art Unit 1624

KH

June 6, 2006